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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte IAN ROSS

Appeal 2009-0446
Application 09/966,023
Technology Center 3600

Decided:¹ July 16, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-2, 9-14, and 18-23 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellant's claimed invention is directed to a self-service terminal associated with an organization having individuals under its supervision, each individual having a sponsor, whereby the terminal provides the individuals with access to financial services provided by a financial institution in accordance with rules established by the sponsor and the organization (Spec. 2:1-5). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of providing financial transactions via a self-service terminal associated with an organization having individuals

under its supervision, the method comprising the steps of:
maintaining a financial account for the organization;

maintaining a financial account for an individual under the supervision of the organization;

allowing a sponsor and/or the organization to establish rules governing use of funds within the financial account by the individual; and when a transaction is requested by the individual at a self-service terminal located in premises used by the organization,

examining the rules and fulfilling the transaction if the transaction is consistent with the established rules for that individual.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Slater US 6,615,190 B1 Sep. 2, 2003

The following rejections are before us for review²:

1. Claims 1-2, 9-14, and 18-23 are rejected under 35 U.S.C. § 102(e) as anticipated by Slater.

THE ISSUE

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regard to claim 1 this issue turns on whether Slater discloses a system in which the organization establishes rules which are then examined at the transaction request.

² We note a typographical error in the Examiner's Answer in the listing of the claims under rejection. The Examiner's Answer at page 3, line 5, lists the claims under rejection under 35 U.S.C. § 102(e) as being claims 1-2, 9-14, and 18-26 while at the same page at line 17, lists the claims under rejection as 1-17. The Final Rejection of Feb. 23, 2007 lists the same typographical error but properly presents the claims under rejection as 1-2, 9-14, and 18-23 with claims 24-26 considered non-elected claims. As such the claims under Final Rejection and subject of this Appeal are claims 1-2, 9-14, and 18-23. The Appellant has presented arguments that the restriction requirement with regards to claims 24-26 made by the Examiner is improper (Br. 8, 38-42) but this is not subject matter which can be appealed to the Board of Patent Appeals and Interferences. *See Manual of Patent Examining Procedure* § 1002.02(c)(2) and 1201 (8th ed., rev. 7, July, 2008).

With regards to claims 2, 11, and 14 this issue turns on whether Slater discloses the step of offering products or services provided by the organization.

With regards to claims 10 and 13 this issue turns on whether Slater discloses that the terminal is located on the premises used by the organization.

With regards to claims 9 and 12 this issue turns on whether Slater discloses a personal computer to maintain the financial account and accessing the account with an ATM machine.

With regards to claims 18-20 this issue turns on whether Slater discloses “wherein the rules limit times-of-day when specific transactions are allowed.”

With regards to claims 21-23 this issue turns on whether Slater discloses that “a non-authorization message is displayed if the requested transaction fails to comply with a rule.”

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence³:

FF1. Slater discloses a sponsor funded stored value card in which a company funds an account associated with the card which is then issued to a

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

cardholder (Abstract). The stored value card replaces the need to issue checks (Col. 1:37-39) to employees which can be costly (Col. 1:11-19).

FF2. Slater discloses that the cardholder is prohibited from depositing funds in the account (Abstract).

FF3. Slater discloses that the funds may be withdrawn at the employee's discretion through known manners of withdrawal, e.g. ATM machines and point of sale (POS) purchases (Col. 2:31-36).

FF4. Slater discloses that an implementation specialist may ensure that applicable government regulations are followed (Col. 3:8-15) in the stored value cards.

FF5. Slater discloses that a sponsor company which sells gasoline may provide customers that meet predetermined criteria (e.g. have purchased twelve tanks of gasoline) a sponsor funded stored value card which can be used to purchase items such as gasoline or oil, at the sponsor company, or affiliated stores (Col. 7:46-52).

FF6. Slater discloses that the system network (Fig. 2) uses a computer (Col. 4:46-50) and an ATM for access by the cardholder (Col. 5:56-58).

FF7. Slater discloses that the sponsor may fund the stored value card at periodic intervals corresponding to the employee's payday (Col. 2:27-32).

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope

of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

Claim 1

The Appellant argues that the rejection of claim 1 is improper because the claim requires “[t]he same set of rules must be found in both (1) the creation of the rules and (2) the application of the rules to the transaction” and that Slater does not disclose this (Br. 11, 15, 29). The Appellant also argues that the government regulations in Slater are not established separately by the organization (Br. 13-14, 20-22) or applied during the transaction (Br. 14-15, 23-24) as the claim requires. The Appellant also argues that Slater fails to show rules in the claimed payment system and within the financial account of the individual (Reply Br. 1-2).

In contrast the Examiner has determined that Slater discloses the claimed limitations because it discloses that the cards operate in a known manner as ATM cards (Ans. 6-7). The Examiner has also determined that when you go to an ATM there are “rules” that are checked before issuing cash or merchandise including whether there is enough cash in the account, whether the card is stolen, and whether the card is valid, etc. (Ans. 7).

We agree with the Examiner. Slater discloses a sponsor funded stored value card in which a company funds an account associated with the card

which is then issued to an employee (FF1). Slater has disclosed that the funds may be withdrawn at the employee's discretion through known manners of withdrawal, e.g. ATM machines (FF3). Conventional ATM cards are well known to routinely have rules established to check to see if the ATM card is valid and if enough funds are in the account when the transaction is requested. As such, Slater discloses a system in which the organization establishes rules for the use of the sponsor cards (for example that you can not exceed a withdrawal beyond the balance of your account) which are then examined at the transaction request. Slater even specifically discloses a example of establishing rules and examining them at the transaction request in disclosing a sponsor funded stored value card which can be used to only purchase items such as gasoline or oil, at the sponsor company, or affiliated stores (FF4) which serves as a "rule" as to the cards use which is then checked during the transaction request. For these reasons the rejection of claim 1 is sustained.

Claims 2, 10-11, and 13-14

Claims 2, 11, and 14 require that the step of offering products or services be provided by the organization. Claims 10 and 13 require that the terminal is located on the premises used by the organization. The Appellant argues that Slater fails to disclose these claimed limitations (Br. 30-32). We agree with the Examiner. Slater discloses these limitations in disclosing that the sponsor funded stored value card can be used to purchase items such as gasoline or oil, at the sponsor company (FF4). For these reasons the rejection of claims 2, 10-11, and 13-14 is sustained.

Claims 9 and 12

The Appellant argues that the rejection of claim 12 under 35 U.S.C. § 102(b) as being anticipated by Slater is improper because the reference fails to teach the limitation for a personal computer to maintain the financial account, accessing the account with an ATM, or an official at school to organize the rules (Br. 33-34). The Appellant also argues that claim 12 should be interpreted in means-plus-function format under 35 U.S.C. § 112, sixth paragraph (Br. 33-34). In contrast the Examiner has determined that Slater discloses these limitations in Figure 2 (Ans. 5).

We agree with the Examiner. Slater discloses using a computer and ATM which are conventionally operated over a network (FF6) whether or not that portion of the claim is accorded patentable weight under 35 U.S.C. § 112, sixth paragraph. Further, claim 12 also recites “means for allowing a sponsor and/or organization to establish rules.” The use of the alternative “or” only requires that one of the sponsor or organization establishes rules and there is no requirement in the claim that an official at school organize the rules. As Slater has shown that a sponsor company may establish a rule as discussed above, this limitation has also been shown by Slater whether or not that portion of the claim is accorded patentable weight under 35 U.S.C. § 112, sixth paragraph. As the Slater reference discloses the limitation argued by the Appellant, the rejection of claim 12 under 35 U.S.C. § 102(b) as being anticipated by Slater is sustained. The Appellant has presented the same arguments for claim 9 and the rejection of this claim is sustained for the same reasons given above.

Claims 18-20

The Appellant argues that Slater fails to disclose the limitation in claims 18-20 that “wherein the rules limit times-of-day when specific transactions are allowed” (Br. 34-35). The Examiner has determined that Slater discloses this limitation in allowing “specific intervals” (Ans. 6).

We agree with the Appellant. The portion of Slater cited by the Examiner only discloses that Slater discloses that the sponsor may fund the stored value card at periodic intervals corresponding to the employee’s payday (FF7). Slater has not disclosed that rules for the individual limit the times-of-day when specific transactions are allowed. For these reasons the rejection of claims 18-20 is not sustained.

Claims 21-23

The Appellant argues that Slater fails to disclose the limitation in claims 21-23 that “a non-authorization message is displayed if the requested transaction fails to comply with a rule” (Br. 35-36). The Examiner has determined that Slater discloses this limitation by displaying a message if the transmission is rejected (Ans. 6).

We agree with the Examiner. Slater discloses that the funds may be withdrawn at the employee’s discretion through known manners of withdrawal, e.g. ATM machines and point of sale (POS) purchases (FF3). ATM machines conventionally display a message of non-authorization if a transaction cannot be completed for failure to comply with a rule, for example to withdraw funds in excess of the account balance. For these reasons the rejection of claims 21-23 is sustained.

CONCLUSIONS OF LAW

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 1-2, 9-14, and 21-23 under 35 U.S.C. § 102(e) as anticipated by Slater.

We conclude that Appellant has shown that the Examiner erred in rejecting claims 18-20 under 35 U.S.C. § 102(e) as anticipated by Slater.

DECISION

The Examiner's rejection of claims 1-2, 9-14, and 21-23 is sustained. The Examiner's rejection of claims 18-20 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

JRG

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